



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Kurt RYF *et al.*

Application No. 09/879,187

Filed: June 13, 2001

For: FUNCTIONAL HIGH-ENERGETIC
MATERIAL

Confirmation No.: 3997

Art Unit: 1755

Examiner: A. B. FELTON

Atty. Docket No. 39021-172671

Customer No.

26694

PATENT TRADEMARK OFFICE

Pre-Appeal Brief Request for Review
[filed concurrently with Notice of Appeal]

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Sir:

A Notice of Appeal with fees is concurrently filed. The final rejection is dated January 29, 2007. This paper is filed under the next business day rule. Review of the final rejections under 35 U.S.C. § 112 and § 102 is respectfully solicited.

REMARKS appear on pages 2-4.

REMARKS

I. Applicants respectfully request reversal of the rejection of claims 19-37 in the "Final", under 35 U.S.C. § 112, first paragraph for lack of enablement. The MPEP Section 2164.04 indicates that the USPTO carries the initial burden to establish a reasonable basis to question enablement and cites *inter alia* two cases, *In re Wright*, 999F.2d 1557, 1562 (Fed. Cir. 1993) and *In re Marzocchi*, 439 F.2d220,224 (CCPA 1971: Marzocchi, expressly excerpted therein, states it is incumbent on the U.S. PTO to "back up assertions.. with acceptable evidence or reasoning which is inconsistent with the contested statement."

The USPTO merely alleges without factual support that the claims are not enabled, asserting the following reasoning:

"include language drawn to a polymeric desensitizing agent which is not described in the specification with sufficient detail to allow one to make and use the invention."

The only evidence of record was provided by applicants and that evidence establishes that the art recognizes the import of the terms "polymer desensitizing" as reflected by CA 2,298,513 (p. 4, line 20 - p.6, line 4) and U.S. 5,043,031 (col. 4, lines 12-19) and US 6, 042,663 (col. 3, lines 1-4). The U.S. PTO's attention is respectfully directed to CA 2,298,513 (p. 4 line, 20 - p.6, line 4) and U.S. 5,043,031 (col. 4, lines 12-19) and US 6, 042,663 (col. 3, lines 1-4); these references refer to polyether and/or polyester as a "desensitizer." [The references were cited in the April 3, 2007 IDS.]

The U. S. PTO offered no evidence of record to dispute that an art recognition of the meaning "polymer desensitizing" does in fact exist.

In so far as the U.S. PTO reference to "in light of the contradicting language regarding the water solubility" is concerned, there is no such "contradicting language" in the claims and in the specification. Claim 19 does not recite either "water soluble" or "water insoluble." The Google extracts were presented on April 3, 2007 [IDS]; these relate to "water soluble polyester" and "water insoluble polyester". Thus whatever the

rationale for the U.S. PTO suggestion that there is "contradicting language" it does not pertain to the issues herein. Withdrawal of the rejection under § 112, first paragraph is respectfully solicited.

II. Applicants respectfully traverse the rejections under 35 U.S.C. § 102 over Coffee and argue the claims separately [as noted in applicants April 3, 2007 Paper at page 12, lines 10-11 .]

The claimed subject matter is not only different from the process and the material disclosed by Coffee US 3,108,916 [hereinafter "Coffee"]; but also Coffee leads away from the rejected subject matter. Please see MPEP Section 2131, which in essence, requires a one-to-one correspondence between the reference disclosure of Coffee and the claim recitation(s) at issue, to properly assert anticipation, on the basis of the description of Coffee.

The rejected claims all recite the following expression of paragraph d) of Claim 19 expressly or by virtue of dependency:

d) diffusing at least one emulsion comprising said energetic plasticizing agent or said polymeric desensitizing agent into the receptive grain to produce the layered grain structure wherein said polymeric desensitizing agent is an organic ester or ether with a molecular weight of 100 to 100000.

By comparison, Coffee states expressly as follows:

"Since the diesters employed have no appreciable solvent power for nitrocellulose, they do not penetrate the surface of the grains. They are present only as a molecular external coating. [Coffee, column 2 lines 10-15.]"

Not only are the steps of the methods entirely different but also Coffee express terms lead away from claim 19 and the claims directly or indirectly dependent thereon.

Applicants direct the U.S. PTO to the disclosures of U.S. 3,290,190, column 1, line 15 and column 2, lines 25 et seq., of 3,290,190 and to the disclosure of 3,779,826 at column 3, line 55 to column 4, line 7. Therein a clear expression of the plastisol process is set forth. That plastisol process is exemplified in the attachment hereto entitled 'Comparison of the invention and Coffee'. That schematic representation sets forth the

requirement of the production of a homogenous rigid body; this is the hallmark of a plastisol process.

The U.S. PTO has not identified one expression in Coffee which corresponds to paragraph (d) of Claim 19. Thus there is no *prima facie* basis for a rejection for anticipation. Since Coffee provides no written description of an element/ recitation of Claim 19 the claims are free of that reference, under 35 U.S.C. § 102.

Applicants/Appellants do argue the claims separately. Coffee does not describe the substances of Claim 23 or Claim 24; specifically rejection of claims 23-24 and 32-33 [or claims 25, or claims 26-31 and claims of Claims 26-31]for anticipation by Coffee is antithetical to MPEP Section 2131. Coffee does not describe the compounds of Claims 32 and 33. Coffee does not describe the diffusion depth of Claim 25. In addition, Coffee does not describe the solvent of Claims 26-31, claims 27-31 being dependent directly or indirectly on Claim 36.

The Coffee reference does not suggest Claim 19. In applicants' view, Coffee's express description ... which is excerpted above ... leads away from the claim recitations in the rejected claims. Accordingly, Coffee can not support a rejection, under 35 U.S.C. § 103, as it leads away from certain claims recitations; and there is no support description in Coffee to reject the dependent claims for the additional recitation(s) set forth in this paragraph.

Respectfully submitted,

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